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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,190	12/22/2000	Timo Kinnunen	367.39429X00	8071

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EXAMINER

HASHEM, LISA

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 06/17/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/742,190

Applicant(s)

KINNUNEN ET AL.

Examiner

Lisa Hashem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

FINAL DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 recites the limitation "the conditions" in line 12 on page 5. There is insufficient antecedent basis for this limitation in the claim.
3. Claim 2 recites the limitations "the content of the multimedia message" in line 18-19 on page 5. There is insufficient antecedent basis for these limitations in the claim.
4. Claim 8 recites the limitation "the size" in line 14 on page 6. There is insufficient antecedent basis for this limitation in the claim.
5. Claim 9 recites the limitation "the volume" in line 2 on page 7. There is insufficient antecedent basis for this limitation in the claim.
6. Claim 10 recites the limitation "the color" in line 5 on page 7. There is insufficient antecedent basis for this limitation in the claim.
7. Claim 19 recites the limitation "the presence" in line 11 on page 8. There is insufficient antecedent basis for this limitation in the claim.
8. Claim 20 recites the limitation "the step" in line 12 on page 8. There is insufficient antecedent basis for this limitation in the claim.
9. Claim 21 recites the limitation "the event" in line 18 on page 8. There is insufficient antecedent basis for this limitation in the claim.
10. Claim 22 recites the limitation "the step" in lines 20-21 on page 8. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-2 and 5-13 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by European Patent Application Publication No. EP 788065 by Jennings.

Regarding claim 1, Jennings discloses a communications device (Figure 1, 106) including a messaging user interface, the interface including means for selecting a component for inclusion in a message, means for selecting conditions under which the message may be opened by a device of a recipient and means for storing said component as a message together with a message header holding the conditions under which the message may be opened by the device of the recipient in a memory of the communication device (see Abstract; page 3, lines 19-38).

Regarding claim 2, a device as claimed in claim 1 mentioned above, wherein Jennings further discloses in which the message header further contains information descriptive of a content of a multimedia message (page 3, line 44-47).

Regarding claim 5, a device as claimed in claim 1 mentioned above, wherein Jennings further discloses the message includes a plurality of components and associated presentation files (see Figure 2; page 3, lines 44-56).

Regarding claim 6, a device as claimed in claim 1 mentioned above, wherein

Jennings further discloses in which at least one component is a multimedia file (page 3, lines 44-50).

Regarding claim 7, a device as claimed in claim 1 mentioned above, wherein Jennings further discloses means for creating a presentation file associated with said component, said file being stored with said message (page 3, lines 51-56).

Regarding claim 8, a device as claimed in claim 7 mentioned above, wherein Jennings further discloses the presentation file contains parameters relating a size and position of a component comprising a video image (page 6, lines 9-15; page 6, lines 54-55).

Regarding claim 9, a device as claimed in claim 7 mentioned above, wherein Jennings further discloses the presentation file inherently contains parameters relating to a volume of a component comprising an audio recording (page 2, lines 9-19; page 4, line 33 – page 6, line 8).

Regarding claim 10, a device as claimed in claim 7 mentioned above, wherein Jennings further discloses the presentation file inherently contains parameters relating to a color and font of a component comprising a text string (page 2, lines 9-19; page 4, lines 30-32).

Regarding claim 11, a device as claimed in claim 1 mentioned above, wherein Jennings further discloses means for formatting the message as an attachment to a short text message (see Abstract; page 6, lines 9-11).

Regarding claim 12, a device as claimed in claim 1 mentioned above, wherein Jennings further discloses means for inherently formatting the message as an email (page 2, lines 34-52; page 3, lines 19-32).

Regarding claim 13, a device as claimed claim 1 mentioned above, wherein

Jennings further discloses a wireless network interface means (see Figure 1; page 3, lines 32-38).

13. Claims 15-18 and 20-21 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by United States Patent No. 6,119,014 by Alperovich et al, hereinafter Alperovich.

Regarding claim 15, Alperovich discloses a method of creating a message with a communications device for delivery to a device of a recipient, comprising: selecting with the communications device a component from a source and defining with the communications device a set of conditions for delivery of the message to the device of the recipient which includes controlling conditions for which the message may be opened by the device of the recipient (see Abstract; column 2, lines 12-18; column 2, line 64 – column 3, line 11; column 3, lines 27-44).

Regarding claim 16, a method as claimed in claim 15 mentioned above, wherein Alperovich further discloses the conditions include data relating to a time of delivery of the message (column 3, lines 27-44; column 4, lines 52-59).

Regarding claim 17, a method as claimed in claim 15 mentioned above, wherein Alperovich further discloses the conditions include data relating to a location for delivery of the message (column 3, lines 27-44; column 5, lines 26-34).

Regarding claim 18, a method as claimed in claim 17 mentioned above, wherein Alperovich further discloses the location is defined by a geographical location (column 5, lines 26-34; column 5, line 59 – column 6, line 3).

Regarding claim 21, a method of opening a message on a communications device the message having first been created in accordance with the method of claim 15 mentioned above, wherein Alperovich further discloses receiving the message, storing the message in the

communication device, analyzing the delivery conditions and in an event that the delivery conditions are met, opening the message (column 4, lines 29-65).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application Publication No. EP 788065 by Jennings in view of U.S. Patent No. 6,421,707 by Miller et al, hereinafter Miller and in further view of U.S. Patent No. 6,108,688 by Nielsen.

Regarding claim 3, a device as claimed in claim 1 mentioned above, wherein Jennings does not disclose a look-up table wherein the table contains entries of locations from which components are selectable.

Miller discloses a communications device (Figure 1, 120) including a messaging user interface (Figure 1, 122; column 3, lines 6-15), the interface including means for selecting a component for inclusion in a message (as shown in Figure 1, 150; column 2, lines 65-66), means for selecting conditions under which the message may be opened (Figure 1, 110; column 2, line 66 – column 3: line 5) and means for storing said component as a message (column 3, lines 16-26) and the message is associated with a message header holding message delivery conditions (see Figure 4g, 412). Miller further discloses entries of locations from which components are selectable (Figure 4a, 401; Figure 4b: E:\temp\wdsatt.txt, E:\temp\WDS-1-14-98.ppt,

C:\1386\Ringout.wav -> these components were selected from different locations on the user's system; column 4, lines 29-40).

It can be seen that Jennings in view of Miller lacks a look-up table wherein the table contains entries of locations from which components are selectable.

Nielsen discloses a communications device (column 2, lines 61-62) including a messaging user interface (Figure 2, 25), the interface including means for selecting a component for inclusion in a message (column 3, lines 64-67), means for selecting conditions under which the message may be opened (column 3, lines 49-51) and means for storing said component (Figure 1, 18) as a message together with a message header holding the message delivery conditions (Figure 1) in a database of the communication device (column 3, lines 36-41). Nielsen further discloses a look-up table (Figure 2, 40) wherein the table contains entries of recipients from which a warning is selectable so the sender can select whether a response from that recipient is necessary prior to the date and time the sender has designated (Figure 2, 30; column 4, lines 53-65).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to include a look-up table wherein the table contains entries as taught by Nielsen, for the device of Jennings in view of Miller, to assist the user in sending a recipient a component in a message. One of ordinary skill in the art would have been lead to make such a modification since a look-up table would allow the user to easily search for entries of locations from which components are selectable rather than using the inherent method of attaching a file to search for the particular component on the user's system. Also, the search criteria in the table can be

designated for 'locations' rather than 'recipients' and a 'component' can be selected in the checkbox rather than a 'warning'.

Regarding claim 4, a device as mentioned in claim 3 above mentioned above, wherein Nielsen further discloses at least one of the locations or 'recipients' in the table are an entry in the database of the communication device (column 4, lines 1-4).

16. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application Publication No. EP 788065 by Jennings in view of U.S. Patent No. 6,421,707 by Miller.

Regarding claim 14, a device as claimed in claim 1 mentioned above, wherein Jennings further discloses the device is a workstation (page 3, lines 19-32).

Jennings does not disclose the device is a radio telephone.

Miller discloses a communications device (Figure 1, 120) including a messaging user interface (Figure 1, 122; column 3, lines 6-15), the interface including means for selecting a component for inclusion in a message (as shown in Figure 1, 150; column 2, lines 65-66), means for selecting the conditions under which the message may be opened (Figure 1, 110; column 2, line 66 – column 3: line 5) and means for storing said component as a message (column 3, lines 16-26) and the message is associated with a message header holding message delivery conditions (see Figure 4g, 412). Miller further discloses a communications device or cellular/PCS telephone (Figure 3, 301) using GSM as a carrier network (Figure 3; column 3, lines 59-61) including a wireless network interface (Figure 4n, 412).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Jennings to include the communication device being a radio

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telephone as taught by the mobile handset of Miller to provide a handset with an improved user interface. One of ordinary skill in the art would have been lead to make such a modification since the communication device being a cellular/PCS telephone can utilize a wireless network interface to send a multimedia message to an equipped device such as a fax to display the message.

17. Claims 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6,119,014 by Alperovich in view of U.S. Patent No. 6,421,707 by Miller.

Regarding claims 19 and 22, a method as claimed in claim 17 mentioned above, wherein Alperovich does not disclose: the location is defined by a presence of a further device, a step of establishing a communications channel with said further device, and subsequently opening at least a portion of said message on said further device.

Miller discloses a communications device (Figure 1, 120) including a messaging user interface (Figure 1, 122; column 3, lines 6-15), the interface including means for selecting a component for inclusion in a message (as shown in Figure 1, 150; column 2, lines 65-66), means for selecting conditions under which the message may be opened (Figure 1, 110; column 2, line 66 – column 3: line 5) and means for storing said component as a message (column 3, lines 16-26) and the message is associated with a message header holding message delivery conditions (see Figure 4g, 412; column 4, lines 29-40). Miller further discloses the conditions include data relating to a location for delivery of the message (Figure 4f, 4g), wherein the location is defined by a presence of a further device (Figure 4t), including a step of establishing a communications

channel with said further device and subsequently opening at least a portion of said message on said further device (column 5, lines 41-49; column 6, lines 25-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Alperovich to include the location is defined by a presence of a further device as taught by Miller to provide a device with many delivery options. One of ordinary skill in the art would have been lead to make such a modification since the device has the capability of sending any attachments it has received to a further device to retrieve said attachment.

18. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6,119,014 by Alperovich in view of European Patent Application Publication No. EP 788065 by Jennings.

Regarding claim 20, a method as claimed in claim 15 mentioned above, wherein Alperovich further discloses creating a SMS message associated with said component (see Abstract; column 2, lines 12-18).

Alperovich does not disclose a step of creating a presentation file associated with said component.

Jennings discloses a communications device (Figure 1, 106) including a messaging user interface, the interface including means for selecting a component for inclusion in a message, means for selecting conditions under which the message may be opened by a device of a recipient and means for storing said component as a message together with a message header holding the conditions under which the message may be opened by the device of the recipient in a memory of the communication device (see Abstract; page 3, lines 19-38). Jennings

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further discloses a step of creating a presentation file associated with said component (see Abstract; page 2, lines 34-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Alperovich to include a step of creating a presentation file as taught by Jennings to provide a multimedia message. One of ordinary skill in the art would have been lead to make such a modification since the device has the capability of creating a multimedia message to send to a recipient.

Response to Arguments

19. Applicant's arguments, see pages 10-13, filed March 29, 2004, with respect to the rejection(s) of claim(s) 1-14 under 35 USC 103(a) being unpatentable by Miller in view of Nielsen and claim(s) 15-22 under 35 USC 102(b) being clearly anticipated by Miller, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of:

EP Application Publication No. 788065 by Jennings, please see the 102(e) rejection(s) above for claims 1-2 and 5-13 and United States Patent No. 6,119,014 by Alperovich, please see the 102(e) rejection(s) above for claims 15-18 and 20-21. Please also see the 103(a) rejection(s) above for claims 3-4 (Jennings in view of Miller in further view of Nielsen), claim 14 (Jennings in view of Miller), claim 19 (Alperovich in view of Miller), claim 20 (Alperovich in view of Jennings), and claim 22 (Alperovich in view of Miller).

20. Applicant's arguments with respect to claims 1-22 received on March 29, 2004 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent No. 6,175,743 by Alperovich et al teach a method for encapsulating header information associated with a SMS message; the header information includes message delivery conditions

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

23. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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24. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9314 (for formal communications intended for entry)

Or call:

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

LH

lh

June 9, 2004

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

